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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,004	07/24/2001	Guido Schaffner	3926.030	5606
7590		03/16/2004	EXAMINER	
Stephan A. Pendorf		LANGEL, WAYNE A		
Pendorf & Cutliff		ART UNIT		
5111 Memorial Highway		PAPER NUMBER		
Tampa, FL 33634-7356		1754		

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09912004

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 2-11-04 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 9-18 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 9-18 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over European 0890389, for the reasons given in the Office action mailed August 11, 2003. Applicant's argument, that the combination of greater than 50 weight percent zirconium oxide as carrier and rhodium as the catalyst are nowhere to be found in European 890,389, is not convincing. European 890,389 discloses in Example B in column 4 a catalyst which includes rhodium and aluminum oxide, and further discloses at column 2, lines 4-8 that aluminum oxide or zirconium oxide may be employed as the catalyst support. Accordingly it would be prima facie obvious to substitute zirconium oxide for the aluminum oxide in the catalyst disclosed in Example B of European 890,389. It would be further obvious to employ greater than 50 weight percent zirconium oxide in such carrier, since one of ordinary skill in the art would expect that if the support is zirconium oxide, that it would then

be substantially all zirconium oxide. There is no evidence on record of unexpected results which would emanate from the use of a combination of greater than 50 weight percent zirconium oxide as carrier and rhodium as the catalyst in the process of European 890,389, versus the catalyst disclosed in Example B of the reference. Applicant's argument, that the catalyst of European 890,389 contains silver, is not convincing, since applicant's claims do not exclude the presence of silver in the catalyst. Applicant's argument, that European 890,389 prefers the presence of additional rare earth metal compounds, is not convincing, since it is well-settled that non-preferred embodiments constitute teachings upon which a prima facie case of obviousness may be based. Accordingly it would be obvious to employ a catalyst which is free of rare earth metal compounds in the catalyst of European 890,389, since the reference merely "prefers" the presence of such rare earth metal compounds.

Claim 18 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no "description support" for employing a porous carrier substance having "a BET of 10 to 500 m²/g". Page 3 of the

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specification discloses a BET of between 10 and 500 m²/g, as opposed to "10 to 500 m²/g".

Applicant is invited to make of record a certified English translation of European 890,389, so that it can be determined exactly what the reference shows or does not show.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne A. Langel whose telephone number is (571) 272-1353. The examiner can normally be reached on Monday through Friday from 8 A.M. to 3:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on (571) 272-1358. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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WAL:cdc

March 10, 2004

WAYNE A. LANGE
PRIMARY EXAMINER